

REMARKS

I. GENERAL

A Final Office Action dated January 9, 2008 finally rejected all of the pending claims in the present application. In response, Applicant filed (concurrent with a petition for revival of the application from unintentional abandonment) a notice of appeal on July 11, 2008. Instead of pursuing that appeal at this time, Applicant takes this opportunity to file a Request for Continued Examination concurrent with presentation of the present amendment.

The outstanding issues raised in the Final Office Action are as follows:

- Claims 1–17, 19–24, 26–29, 32–34, 37–39, and 43–45 are rejected under 35 U.S.C. § 102(e); and
- Claims 18, 25, 30, 31, 35, 36, 40–42, and 46–48 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in light of the amendments and remarks contained herein.

II. AMENDMENTS

Claims 1-48 are canceled without prejudice herein, and new claims 49-105 are added.

Support for the limitations in the newly-added claims can be found throughout the specification, drawings, and claims as originally filed (*see e.g.*, Figures 1, 4A, and 5A, and discussions thereof), and in U.S. Pat. App. Ser. No. 09/234,297 (now U.S. Pat. No. 6,272,493), which is incorporated by reference in the present application, *see e.g.*, col. 4, lines 35-42, col. 8, line 25 – col. 9, line 6, and col. 57, lines 55-61 of the incorporated U.S. Pat. No. 6,272,493.

Rather than reciting a “content manifestation environment” (as in the canceled claims), the newly-added claims recite a “browser window”. The specification describes various embodiments in which a browser window is displayed, and thus no new matter is introduced by

this amendment. “Browser window” is not restricted by the definition of “content manifestation environment” presented in the specification of the present application.

Also, rather than reciting “dynamically manifest” or “dynamically manifesting” (as in the canceled claims), at least some of the newly-added claims recite “output”. This is intended to ensure that the limitation is not limited by any definitions in the specification concerning manifesting. For instance, the use of “output” is intended to ensure that the limitation is not restricted to rendition of content in a window module (as opposed to the definition of dynamic manifestation presented in the specification).

Also, rather than reciting “content source”, at least some of the newly-added claims recite “data source”. This is intended to ensure that the limitation is not limited by any definition attributed to “content” in the specification.

Also, rather than reciting “a server system”, at least some of the newly-added claims recite “a processor-based server system”. This amendment is intended to clarify that the “server system” may include one or more processor-based servers. The server system is recited as being “processor-based” to ensure that it is not encompassing mere non-functional software code. Support for “processor-based” servers can be found at least at the discussion of Figure 2, *see e.g.*, page 11 line 8 – page 12, line 18 of the specification.

Independent claim 49 recites that the moveable shopping cart display “being positionally-moveable while displayed”. This clarifies that the moveable shopping cart is positionally-moveable while being displayed, rather than moving to/from a display. In other words, this clarifies that the “moveable” does not merely refer to appearing and disappearing from view on a display, as is the case with the applied *Spiegel* reference as discussed further below.

Also, various claims recite “shopping cart display” instead of “shopping cart window object” (as was recited in some of the canceled claims). “Shopping cart display” is intended to be a broader term that encompasses a shopping cart window object, but which is not limited by

the definition of “window object”. The specification shows (in its Figures) and describes exemplary shopping cart displays, such as the floating shopping cart 416 of Figure 4A described in paragraph 0064, which need not be restricted to the specific definition of a window object (presented in paragraph 0027). Thus, no new matter is introduced by this language.

Similarly, certain claims recite “television display” instead of “television window object”. “Television display”, as recited, is intended to be a broader term that encompasses a television window object, but which is not limited by the definition of “window object” presented in the specification of the present application. The specification shows (in its Figures) and describes exemplary television displays, such as the floating television 514 of Figure 5A described in paragraph 0067, which need not be restricted to the specific definition of a window object (presented in paragraph 0027). Thus, no new matter is introduced by this amendment.

Certain claims, such as claim 60, recite an image plane of a display. The specification shows (in its Figures) and describes exemplary television and shopping cart displays being presented within a browser window, such as the floating shopping cart 416 of Figure 4A described in paragraph 0064 and the floating television 514 of Figure 5A described in paragraph 0067. Those of ordinary skill in the art will readily understand that the floating and/or draggable displays shown and described are positionally moveable within the display plane of a browser window. Thus, no new matter is introduced by this further amendment.

Certain claims, such as claims 53 and 85, recite an individually-controllable, floating shopping cart display or individually-controllable, floating television display. The specification shows (in its Figures) and describes exemplary individually-controllable, floating shopping cart and television displays, such as the floating shopping cart 416 of Figure 4A described in paragraph 0064 and the floating television 514 of Figure 5A described in paragraph 0067, which need not be restricted to the specific definition of a window object (presented in paragraph 0027). Thus, no new matter is introduced by this amendment.

Certain claims, such as claims 51 and 52, recite that the browser window is not required to be refreshed in its entirety. Support for this limitation can be found at least in U.S. Pat. App. Ser. No. 09/234,297 (now U.S. Pat. No. 6,272,493), which is incorporated by reference in the present application, *see* paragraph 0039 of the present application. For instance, support for this limitation may be found at least at col. 4, lines 35-42, col. 8, line 25 – col. 9, line 6, and col. 57, lines 55-61 of the incorporated U.S. Pat. No. 6,272,493.

III. NOTICE OF RELATED LITIGATION AND DISCUSSION OF INFORMATION DISCLOSURE STATEMENT (IDS)

Applicant hereby calls to the Examiner's attention that certain patents related to the present application are involved in a litigation proceeding. In such litigation proceeding, a special master presented a recommendation to the court with regard to construction of various claim terms, *see* Special Master's Report and Recommendation Regarding Claim Construction (cited as item no. CT8 in the information disclosure statement submitted March 2, 2007). The special master's recommendation has not yet been adopted by the court. Some of the claim terms construed in the special master's report were also present in the original claims of the present application (e.g., "window object" and "content"). To alleviate some of the issues raised by the special master, Applicant has canceled the original claims and presented new claims that do not use certain terms that were at issue in the special master's report (e.g., "window object" and "content").

The information available on the USPTO's PAIR system indicates that the IDS submitted on March 2, 2007 has been considered by the Examiner. If this is inaccurate, Applicant requests clarification from the Examiner.

Due to the large size of the March 2, 2007 IDS, Applicant notes, for the convenience of the Examiner, several references submitted in such IDS that may be of particular interest to the Examiner in examining the claims of the present application:

1) Special Master's Report and Recommendation Regarding Conception, cited as item no. CS8 on sheet 15 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

2) Special Master's Report and Recommendation Regarding Claim Construction, cited as item no. CT8 on sheet 15 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

3) Special Master's Report and Recommendation Regarding Anticipation and Obviousness, cited as item no. CV8 on sheet 15 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

4) Special Master's Report and Recommendation Regarding Inequitable Conduct, cited as item no. CW8 on sheet 15 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

5) Special Master's Report and Recommendation Regarding Enablement, cited as item no. CE7 on sheet 12 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

6) Special Master's Report and Recommendation Regarding Written Description, cited as item no. CF7 on sheet 12 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

7) Special Master's Report and Recommendation Regarding Claim Definiteness, cited as item no. CG7 on sheet 12 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO);

8) Special Master's Report and Recommendation Regarding Inventorship, cited as item no. CH7 on sheet 12 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO); and

9) Videotaped deposition of Sandro Pasquali (one of the inventors named on the present application), cited as item no. CR6 on sheet 11 of the form 1449 of the March 2, 2007 IDS, for related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO).

By noting above certain ones of the references submitted in the March 2, 2007 IDS, Applicant does not necessarily agree with or adopt any of the positions taken or conclusions reached in those references. Instead, Applicant merely notes that those references may be of particular interest to the Examiner in her consideration of the present application. In addition, by noting the above references, Applicant does not intend to detract the Examiner's attention away from or discourage the Examiner from fully considering all of the references. Again, Applicant understands that the Examiner has considered all of the references submitted in the March 2, 2007 IDS, including those specifically noted above. If this understanding is inaccurate, Applicant requests clarification from the Examiner.

In addition, Applicant also submits herewith a further IDS disclosing a recent motion for summary judgment of invalidity under 35 U.S.C. §103(a) for the related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO).

Also, Applicant hereby notifies the Examiner that Applicant has received a motion for summary judgment of no willful infringement for the related patents at issue in Civil Action Number CV 02-2748 (DRH)(MLO). However, because the issue of willful infringement is not relevant to the patentability of the claims, Applicant does not include this motion in the IDS. If the Examiner believes that such motion may be of interest or pertinent in any way to the examination of the present application, Applicant invites the Examiner to request submission of the motion in an IDS. Applicant will submit the motion upon request from the Examiner; otherwise, the motion is believed to be immaterial to the issue of patentability of the claims in the present application.

IV. REJECTIONS UNDER 35 U.S.C. § 102(e)

Claims 1–17, 19–24, 26–29, 32–34, 37–39, and 43–45 were finally rejected under 35 U.S.C. § 102(e) as being anticipated by Spiegel et al., U.S. Patent No. 6,629,079 (hereinafter *Spiegel*). The rejections are now moot in view of those claims being canceled without prejudice herein. Applicant respectfully submits that *Spiegel* fails to teach all elements of newly-added

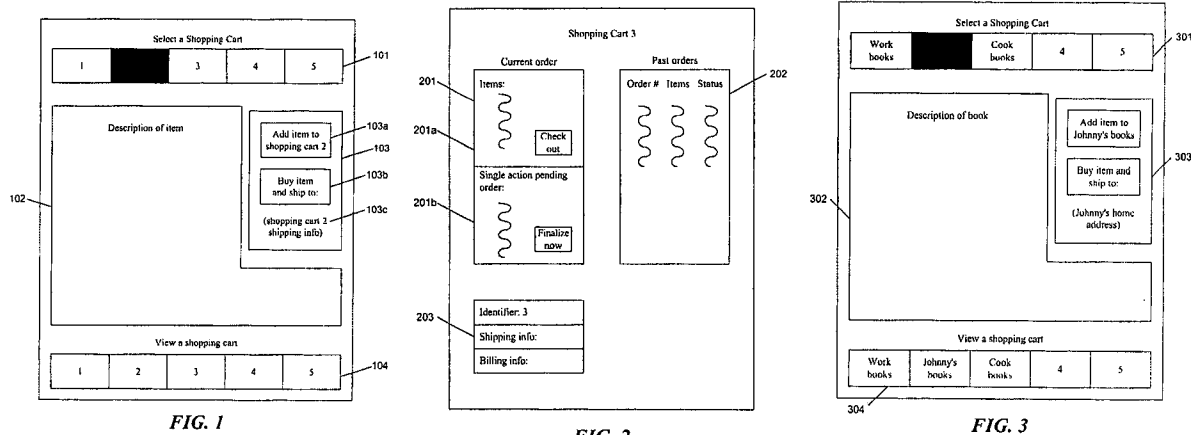
claims 49-105, for the reasons discussed further below, and thus *Spiegel* fails to anticipate these claims under 35 U.S.C. § 102.

A. Claims 49-58

Claim 49 requires, *inter alia*:

... wherein said software system is operable to output a moveable shopping cart display within a web browser window rendered by said web browser client when said software system is received and processed by said web browser client, said moveable shopping cart display being positionally-moveable while displayed.... (emphasis added).

The applied *Spiegel* reference is completely silent on a moveable [shopping cart] display. *Spiegel* makes no mention of positionally moving a shopping cart display or anything else for that matter. Figures 1 – 3 of *Spiegel* depict various displays, none of which are described as having or appear to depict moveable displays.



In the Final Office Action, the Examiner contends that *Spiegel* discloses the movement of a shopping cart, *citing* Col. 4, lines 12-67 of *Spiegel*. The Final Office Action explains, at page 21 thereof, that:

The cited section discloses that multiple shopping carts are used but that the user is able to only view one shopping cart at a time (see Fig 2). Utilizing the

shopping cart viewing navigation bar the user selects which shopping cart to view. When a user selects to view a different shopping cart the current shopping cart is moved from the viewing area and replaced by the newly selected shopping cart.... Thus, all of the shopping carts exist, but user has the ability to swap the currently displayed shopping cart with a second shopping cart and thus provide moveable limitations imposed by the claims as currently written.

Thus, the Examiner contends that the asserted ability of a user to select to display any of various different shopping carts in *Spiegel* meets the limitation of a “a moveable shopping cart window” as previously recited in independent claim 1. For the reasons discussed further below, Applicant respectfully submits that such selecting of a shopping cart to be displayed, as taught in *Spiegel*, does not satisfy the limitation of a moveable shopping cart display. Indeed, as previously argued by Applicant, *Spiegel* does not teach that its shopping cart is moveable at all.

Claim 49 clarifies that the moveable shopping cart is positionally-moveable while being displayed, rather than moving information to/from a display. In other words, this clarifies that the “moveable” term in claim 49 does not merely refer to appearing and disappearing of information to/from view on a display, as is the case with the applied *Spiegel* reference as discussed below.

In *Spiegel*, a shopping cart selection navigation bar 101 (Fig. 1) is provided that “allows the user to switch between shopping carts using a single action

(e.g., a mouse click).” Col. 4, lines 30-32. Subsequent actions taken by the user are performed with respect to the currently-selected shopping cart. For instance, “[w]hen a user indicates to add an item to a shopping cart, the system adds the item to the currently selected shopping cart.” Col. 4, lines 40-42. Clearly, the mere switching between currently-selected shopping carts via selection navigation bar 101 in *Spiegel* does not, in any way, teach

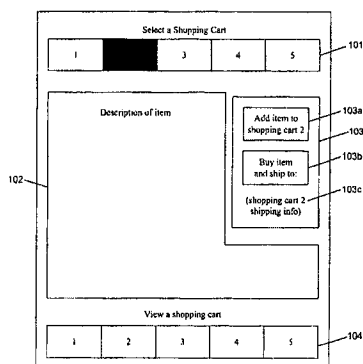


FIG. 1

that the shopping cart is positionally moveable while being displayed.

Spiegel also provides a shopping cart viewing navigation bar 104 (Fig. 1) “through which a user can select to view information relating to a certain shopping cart.” Col. 4, lines 58-61.

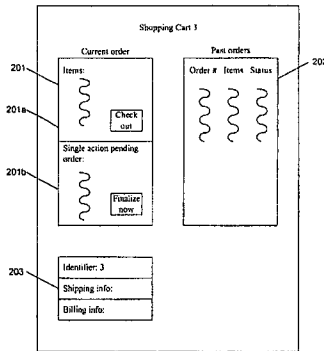


FIG. 2

As shown in Fig. 2, “[W]hen a shopping cart is selected from the viewing navigation bar, the system displays information describing the current contents of the selected shopping cart, information describing past orders that were checked out of that shopping cart, context naming information (e.g., suggestive of the role for which the shopping cart is used), and billing and shipment information.” Col. 4, lines 61-67. Clearly, the mere display of such contents of a currently-

selected shopping cart in *Spiegel* does not, in any way, teach that the shopping cart is positionally moveable while being displayed.

The Examiner appears to contend in the Final Office Action that the selective presentation in *Spiegel* of the contents of a currently-selected shopping cart (and hiding from view the contents of non-selected shopping carts), as a result of a user’s selection of which shopping cart is to be viewed (via shopping cart viewing navigation bar 104), constitutes “moving” the shopping cart. Applicant disagrees and respectfully submits that reading “moveable shopping cart display” so broad as to encompass such presentation of contents of a currently-selected shopping cart in a positionally-static view is not a reasonable interpretation of this limitation.

Nevertheless, in an effort to advance prosecution, Applicant has presented claim 49 to clarify that the moveable shopping cart is positionally-moveable while being displayed. At best, *Spiegel* merely refers to switching between presentation of contents of different shopping carts in a positionally-static interface. That is, based upon which shopping cart is currently-selected, the contents of the currently-selected shopping cart appear to be presented in a positionally-static interface in *Spiegel*, such as illustrated in Fig. 2 of *Spiegel*. This enables the user to switch the information being presented in the positionally-static interface from displaying contents of a first shopping cart to displaying contents of a different shopping cart (based on which shopping cart is

selected via navigation bar 104 for viewing). However, this in no way teaches a positionally moveable shopping cart display within a web browser window, as recited by claim 49. Again, *Spiegel* makes no mention whatsoever of moving the interface in which the contents of the shopping cart are displayed, but instead appears to provide a positionally-static interface in which contents of a currently-selected shopping cart may be displayed.

Thus, Applicant respectfully reiterates that *Spiegel* fails to teach a moveable shopping cart display that is positionally-moveable while displayed, as recited by claim 49. Therefore, *Spiegel* fails to anticipate claim 49 for at least this reason.

Claims 50-58 each depend directly or indirectly from independent claim 49, each inherit the limitations of claim 49. As such, claims 50-58 are each patentable over *Spiegel* as well.

B. Claims 59-69

Independent claim 59 requires “...processing said software system by said web browser client to output a positionally-moveable shopping cart display within a web browser window provided by said web browser client” (emphasis added). As discussed above with claim 49, *Spiegel* fails to teach a moveable shopping cart display that is positionally moveable within a web browser window. Instead, *Spiegel* merely describes a positionally-static interface in which information corresponding to a user-selected one of a plurality of different shopping carts is presented. Therefore, *Spiegel* does not teach all of the limitations of claim 59.

Claims 60-69 each depend directly or indirectly from independent claim 59 and, thus, inherit each of the limitations of claim 59. As such, claims 60-69 are each patentable over *Spiegel* as well.

C. Claims 70-78

Independent claim 70 requires, “...wherein said controllable shopping cart display is positionally moveable within said web browser window” (emphasis added). Again, *Spiegel*

lacks any teaching of a shopping cart display that is positionally moveable within a web browser window. Therefore, *Spiegel* does not teach all of the limitations of claim 70.

Claims 71-78 each depend directly or indirectly from independent claim 70 and, thus, inherit each of the limitations of claim 70. As such, claims 71-78 are each patentable over *Spiegel* as well.

D. Claims 79-88

Independent claim 79 requires, "...wherein said software system is operable to output a moveable television display within a web browser window rendered by said web browser client when said software system is received and processed by said web browser client, said moveable television display being positionally moveable within said web browser window" (emphasis added). *Spiegel* does not teach a moveable television display that is "positionally moveable within a web browser window". Therefore, *Spiegel* does not teach all of the limitations of claim 79.

Claims 80-88 each depend directly or indirectly from independent claim 79 and, thus, inherit each of the limitations of claim 79. As such, claims 80-88 are each patentable over *Spiegel* as well.

E. Claims 89-97

Independent claim 89 requires, "...processing said software system by said web browser client to output a moveable television display within a web browser window provided by said web browser client; and outputting an audio-visual program received from an audio-visual program data source via said electronic data network within said moveable television display and without requiring a refresh of said web browser window in its entirety...." (emphasis added). *Spiegel* does not teach a moveable television display being moveable within a web browser window. Further, *Spiegel* does not teach or suggest a television display within a web browser

window that outputs an audio-visual program without requiring a refresh of the web browser window in its entirety. Therefore, *Spiegel* does not teach all of the limitations of claim 89.

Claims 90-97 each depend directly or indirectly from independent claim 89 and, thus, inherit each of the limitations of claim 89. As such, claims 90-97 are each patentable over *Spiegel* as well.

F. Claims 98-105

Independent claim 98 requires, "...wherein said controllable television display is positionally moveable within said web browser window" (emphasis added). *Spiegel* does not teach a television display that is positionally moveable within a web browser window. Therefore, *Spiegel* does not teach all of the limitations of claim 98.

Claims 99-105 each depend directly or indirectly from independent claim 98 and, thus, inherit each of the limitations of claim 98. As such, claims 99-105 are each patentable over *Spiegel* as well.

V. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 18, 25, 30, 31, 35, 36, 40-42, and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Spiegel* in further view of Hall, Marty, "Core Web Programming," 1998 (hereinafter *Hall, Marty*). Those claims are canceled without prejudice herein, and thus the rejections are now moot. Further, Applicant respectfully submits that the disclosure of *Hall, Marty* fails to resolve the above-noted deficiencies in *Spiegel* regarding claims 49-105. Therefore, these claims are also believed to be patentable over the combination of *Spiegel* and *Hall, Marty*.

VI. CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes an RCE fee of \$405.00 and additional claims fee of \$234.00 is due with this response. Please charge any additional fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 65164/P001CP1/10606083 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: January 2, 2009

Respectfully submitted,

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